

Applicant: Juha Maijala et al.  
Application No.: 10/507,436  
Response to Office action dated Apr. 10, 2008  
Response filed July 8, 2008

### Remarks

Claims 20–43 remain pending in the application. Claims 44–47 have been canceled. In the Office action dated Apr. 10, 2008, claims 20–43 were rejected as obvious over Bando EP 0982120A1.

Claims 20 and 31 have been amended to claim “a homogeneous dry coating powder formed from 70–99% inorganic material *consisting essentially of particles* having a size of greater than 1  $\mu\text{m}$  to 500  $\mu\text{m}$ .”

MPEP section 2111.03 sets forth –The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention.

Bando sets forth a coating powder composition containing as an essential component inorganic fine particles having an average diameter of 1 nm to 1  $\mu\text{m}$  (abstract lines 6–7) and also disclosed is “a surface layer comprising inorganic fine particles having an average particle diameter of 1 to 50 nm on the resin layer” (p. 3, lines 19–20). More generally Bando sets forth

a substrate and a porous and continuous resin layer provided on the substrate, the resin layer comprising particles of the powdery coating composition having an average particle diameter of 0.1 to 30  $\mu\text{m}$  and inorganic fine particles having an average particle diameter of 1 nm to 1  $\mu\text{m}$  and dispersed between the particles of powdery coating composition to form space at least in part therebetween.... The sheet can be obtained according to the invention by... fixing the coating composition together with the inorganic fine particles on the substrate to form a resin layer comprised of the powdery coating composition.  
(Abstract)

It is these necessary inorganic fine particles which the specification identifies as essential but notes that they are not workable if greater than 1  $\mu\text{m}$ :

On the other hand, when the average particle diameter is larger than 1  $\mu\text{m}$ , it is difficult to fix a powdery mixture of the inorganic fine particles and powdery coating composition on a substrate after dry-coating it on the substrate and melting by heating. Accordingly, the resin layer formed is peeled off from the substrate thereby to cause defects in the resulting coated

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sheet. Therefore, a high quality image recording cannot be obtained even if such a sheet coated with a powdery coating is used in an image-receiving sheet for an ink-jet recording.

(P. 8, lines 11–15.)

This limitation “*consisting essentially of particles* having a size of 0.1 –500  $\mu\text{m}$ ” finds support in the specification. Paragraph [0014] states “The average diameter of the material particles is usually 0.1–500  $\mu\text{m}$ , preferably 1–15  $\mu\text{m}$ .” *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) describes a situation where applicants disclosed range of solids content of 25–60% was held to support a latter claimed range of 35-60%. The Court held that where applicants disclose a range, they have taught possession of all the values within that range, and burden of showing that the claimed invention is not described in the specification rests on the examiner in the first instance, so it is up to the examiner to give reasons why a description not in *ipsis verbis* is insufficient.

Also MPEP 2163.05 III. RANGE LIMITATIONS provides that:

With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. In the decision in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), the ranges described in the original specification included a range of “25%- 60%” and specific examples of “36%” and “50%.” A corresponding new claim limitation to “at least 35%” did not meet the description requirement because the phrase “at least” had no upper limit and caused the claim to read literally on embodiments outside the “25% to 60%” range, however a limitation to “between 35% and 60%” did meet the description requirement.

Here applicants claimed range *consisting essentially of particles* having size of greater than 1  $\mu\text{m}$  to 500  $\mu\text{m}$  falls within the range of “The average diameter of the material particles is usually 0.1–500  $\mu\text{m}$ , preferably 1–15  $\mu\text{m}$ .”

The claims as amended clearly distinguish over Bando in the claimed coating method of coating applying a homogeneous coating *consisting essentially of particles* having size of greater than 1  $\mu\text{m}$  to 500  $\mu\text{m}$ .

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Applicant believes that no new matter has been added by this amendment.

Applicant submits that the claims, as amended, are in condition for allowance.

Favorable action thereon is respectfully solicited.

Respectfully submitted,



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